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First Named Inventor

Poltorak, Alexander I.

Art Unit

3629

Examiner Name

Mooneyham, Janice A.

Attorney Docket Number

AP IPW001

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October 20, 2006

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43,229

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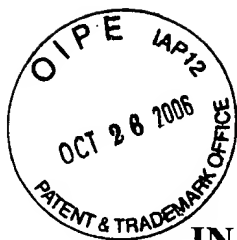
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AP IPW001 UTL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Alexander I. POLTORAK

Serial No.: **09/730,232**

Filed: **December 5, 2000**

For: **METHOD AND SYSTEM
FOR SEARCHING AND
SUBMITTING ONLINE VIA
AN AGGREGATION PORTAL**

Art Unit: **3629**

Examiner: **Janice A. MOONEYHAM**

Examiner's Answer Mailed On: **Sept. 27, 2006**

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REPLY BRIEF TO THE
BOARD OF PATENT APPEALS AND INTERFERENCES

This Reply Brief is responsive to the Examiner's answer mailed on September 27, 2006, in the above-referenced patent application (the "Examiner's Answer"). Because the Examiner's Answer appears to contain a new ground of rejection, Applicant-Appellant requests maintenance of the Appeal. This Reply Brief is being filed within two months of the mailing date of the Examiner's Answer. Therefore, the Reply Brief is timely. In accordance with MPEP § 1208(I), the Reply Brief

includes these status pages, status of claims page, grounds of rejection to be reviewed on appeal page, and argument pages.

No fees are needed to file this Reply Brief. If the undersigned attorney is mistaken in this regard, authorization is hereby granted to charge all fees necessary to file this Reply Brief to Deposit Account No. 50-3196.

Applicant-Appellant relies on the Appeal Brief for exposition of the grounds for reversal of the rejections, and takes this opportunity to respond to a number of arguments made in the Examiner's Answer, including the new ground of rejection. Applicant-Appellant intends this Reply Brief to supplement the Appeal Brief, rather than to replace it.

I
STATUS OF CLAIMS

The status of claims in the instant application is as follows:

Claims 1-47, 49-53, 66-72, and 86-88 have been rejected and are pending.

Applicants appeal from the rejection of claims 1-47, 49-53, 66-72, and 86-88.

II

GROUND OF REJECTION TO BE REVIEWED

1. Claims 1, 4, 20, and 39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lundberg, U.S. Patent Application Publication Number 2002/0091541 (“Lundberg” hereinafter).

2. Claims 21, 45, 46, and 49-53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tran, U.S. Patent Application Publication Number 2002/0095368 (“Tran” hereinafter) in view of Peter Fischer, *Opening the Vault*, Software Magazine (2000) (“Fischer” hereinafter).

3. Claims 22-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tran and Fischer, and further in view of Ralph Kimball, *Fundamental Grains*, Intelligent Enterprise (1999) (“Kimball” hereinafter).

4. Claims 2, 3, 5-7, 11-16, 19, 40-44, 47, 67-69, 71, 72, and 86-88 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lundberg in view of Tran.

5. Claims 8-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lundberg in view of Boyer *et al.*, U.S. Patent Number 6,879,990 (“Boyer” hereinafter).

6. Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lundberg in view of Fischer and Kimball.

7. Claims 66 and 70 appear to stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tran.¹

¹ The Office Action from which this Appeal is taken rejected claims 66 and 70 under 35 U.S.C. § 103(a) as being unpatentable over Lundberg and Tran. The Examiner’s Answer at pages 15-19 repeated the § 103(a) rejection, but at pages 48-49 explained that the proper rejection of these claims would have been under § 102(e) as being anticipated by Tran. It appears that the claims stand rejected under § 102(e) as being anticipated by Tran.

III

ARGUMENT

A. Rejection of Claim 1 as Being Anticipated by Lundberg

In the Appeal Brief we argued that Lundberg fails to disclose the step of “establishing a connection to a plurality of third-party sources of intellectual property listings available for transacting.” In particular, we argued that Lundberg does not disclose *available for transacting*, in the sense of available for exchange or transfer, such as sale, licensing, and similar activities. We pointed to a number of places where the specification employs various inflectional morphemes of the word *transact* to refer to the most conventional meaning of *transaction*, that of exchange or transfer of goods, services, funds, and other property. We further argued that the construction of the word *transaction* in the sense of “discrete activity within a computer system such as an entry of a customer order or an update of an inventory item” is unreasonable in the present context, because a person skilled in the relevant art would not understand *transacting* as a reference to “discrete activity within a computer” in light of the specification of this application.

In response to this argument, the Examiner’s Answer did not point to any portion of the specification that might provide even the most tenuous support for the very specialized meaning of the term *transacting* on which the Examiner’s Answer relies. The Examiner’s Answer also did not point to any part of prosecution history as supporting the construction of *transacting* as “discrete activity within a computer.” To the contrary, we have consistently argued in response to substantive Office actions in this case that such construction is unreasonable. Thus, it appears unchallenged that both intrinsic sources of claim construction provide no support for construing *transacting* as

“discrete activity within a computer.”

Instead of basing the construction of *transacting* on the intrinsic sources, the Examiner’s Answer once again quotes a definition of *transaction* from a technical dictionary, an extrinsic source.

The controlling precedent regarding the use of intrinsic and extrinsic sources for determining the scope of the claims is a relatively recent opinion in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 U.S.P.Q.2D 1321 (Fed. Cir. 2005) (*en banc*). In this *en banc* decision, the Court of Appeals for the Federal Circuit underscored that one of ordinary skill in the art reads claims not in the vacuum, but in the context of the intrinsic record: “Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Phillips v. AWH Corp.*, 415 F.3d at 1313.

The Court of Appeals for the Federal Circuit left little doubt regarding the relative roles of the specification and extrinsic sources such as dictionaries in the process of claim construction, noting that the specification “is always highly relevant to the claim construction analysis,” and “[u]sually, it is dispositive; it is the single best guide to the meaning of a disputed term.” *Phillips v. AWH Corp.*, 415 F.3d at 1315 (*quoting from Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). The *en banc* Court of Appeals for the Federal Circuit then urged that this principle was well established in its own precedents, precedents of its predecessors (the CCPA and the Court of Claims), and Supreme Court precedents:

This court and its predecessors have long emphasized the importance of the specification in claim construction. In *Autogiro Co. of America v. United States*, 181 Ct. Cl. 55, 384 F.2d 391, 397-98 (Ct. Cl. 1967), the Court of Claims characterized the specification as “a concordance for the claims,” based on the statutory requirement

that the specification "describe the manner and process of making and using" the patented invention. The Court of Customs and Patent Appeals made a similar point. *See In re Fout*, 675 F.2d 297, 300 (CCPA 1982) ("Claims must always be read in light of the specification. Here, the specification makes plain what the appellants did and did not invent . . .").

Shortly after the creation of this court, Judge Rich wrote that "the descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims." *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985). On numerous occasions since then, we have reaffirmed that point, stating that "the best source for understanding a technical term is the specification from which it arose, informed, as needed, by the prosecution history." *Multiform Dessicants*, 133 F.3d at 1478; *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1360 (Fed. Cir. 2004) ("In most cases, the best source for discerning the proper context of claim terms is the patent specification wherein the patent applicant describes the invention."); *see also, e.g., Kinik Co. v. Int'l Trade Comm'n*, 362 F.3d 1359, 1365 (Fed. Cir. 2004) ("The words of patent claims have the meaning and scope with which they are used in the specification and the prosecution history."); *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1315 (Fed. Cir. 2003) ("The best indicator of claim meaning is its usage in context as understood by one of skill in the art at the time of invention.").

That principle has a long pedigree in Supreme Court decisions as well. *See Hogg v. Emerson*, 47 U.S. (6 How.) 437, 482, 12 L. Ed. 505 (1848) (the specification is a "component part of the patent" and "is as much to be considered with the [letters patent] in construing them, as any paper referred to in a deed or other contract"); *Bates v. Coe*, 98 U.S. 31, 38, 25 L. Ed. 68, 1879 Dec. Comm'r Pat. 365 (1878) ("in case of doubt or ambiguity it is proper in all cases to refer back to the descriptive portions of the specification to aid in solving the doubt or in ascertaining the true intent and meaning of the language employed in the claims"); *White v. Dunbar*, 119 U.S. 47, 51, 30 L. Ed. 303, 7 S. Ct. 72, 1886 Dec. Comm'r Pat. 494 (1886) (specification is appropriately resorted to "for the purpose of better understanding the meaning of the claim"); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217, 85 L. Ed. 132, 61 S. Ct. 235, 1941 Dec. Comm'r Pat. 802 (1940) ("The claims of a patent are always to be read or interpreted in light of its specifications."); *United States v. Adams*, 383 U.S. 39, 49, 15 L. Ed. 2d 572, 86 S. Ct. 708, 174 Ct. Cl. 1293 (1966) ("It is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention.").

Phillips v. AWH Corp., 415 F.3d at 1315-1316.

The Court of Appeals for the Federal Circuit then went on to explain the proper claim construction process during patent prosecution:

The pertinence of the specification to claim construction is reinforced by the manner in which a patent is issued. The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 C.F.R. § 1.75(d)(1).

Phillips v. AWH Corp., 415 F.3d at 1316-1317. Thus, it is well established that claims must be given their broadest reasonable construction not in the vacuum, as the Examiner's Answer attempts to do, but "in light of the specification as it would be interpreted by one of ordinary skill in the art."

Although the Court of Appeals for the Federal Circuit acknowledged that extrinsic evidence such as dictionaries "can be useful in claim construction," *Phillips v. AWH Corp.*, 415 F.3d at 1318, it also pointedly elaborated a number of reasons why extrinsic evidence is less reliable than intrinsic evidence. *Phillips v. AWH Corp.*, 415 F.3d at 1318. In particular, the Court noted that "extrinsic evidence by definition is not part of the patent and does not have the specification's virtue of being created at the time of patent prosecution for the purpose of explaining the patent's scope and meaning." *Id.* The Court also emphasized that "undue reliance on extrinsic evidence poses the risk that it will be used to change the meaning of claims in derogation of the 'indisputable public records consisting of the claims, the specification and the prosecution history,' thereby undermining the

public notice function of patents.” *Phillips v. AWH Corp.*, 415 F.3d at 1319 (quoting from *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995)).

Specification is the primary source for determining meaning of the claim terms. Dictionaries and other external sources should not be used “in derogation” of this source.

Finally, we would like to draw the honorable Board’s attention to one post- *Phillips v. AWH Corp.* case that speaks directly on the issue of construing a claim term in the presence of multiple dictionary definitions. In *Free Motion Fitness, Inc. v. Cybex Int’l, Inc.*, 423 F.3d 1343, 76 U.S.P.Q.2d 1432 (Fed. Cir. 2005), the Court’s opinion explained that

[u]nder *Phillips*, the rule that a court will give a claim term the full range of its ordinary meaning, . . . does not mean that the term will presumptively receive its broadest dictionary definition or the aggregate of multiple dictionary definitions, Rather, in those circumstances where reference to dictionaries is appropriate, the task is to scrutinize the intrinsic evidence in order to determine the most appropriate definition.

Free Motion Fitness, 423 F.3d at 1348-49 (internal quote marks and citations omitted). The dissent agreed with this statement of the law. *Free Motion Fitness*, 423 F.3d at 1354.

In our case, the Examiner’s Answer does not scrutinize the specification to determine the most appropriate definition of the term *transacting*, as required by *Phillips* and its progeny. Instead, the Examiner’s Answer and the rejection from which this appeal is taken presumptively give the term *transacting* the aggregate of the dictionary definitions. This approach is contrary to the controlling precedents of the Court of Appeals for the Federal Circuit. For this reason, we respectfully request reversal of the rejections.

B. Rejection of Claim 21 as Being Unpatentable over Tran and Fischer

Claim 21 recites *inter alia* steps of *e) taking a snapshot of each of said third-party sources of intellectual property listings, g) reformatting each of said snapshots in a predetermined format, and h1) searching through said reformatted snapshots in said second memory storage area for matches with the user search criteria*. As admitted in the Examiner's Answer (page 8), Tran does not specifically disclose reformatting or taking a snapshot. The Examiner's Answer argues (page 8) that Fischer discloses both reformatting and snapshots, and that it would have been obvious to incorporate into Tran the "the information portals with XML repositories taught in Fisher so as to provide access to a wide array of corporate information in disparate databases and processing systems, wherein the data is gathered by the freezing of data at a predetermined point in time, thus giving a more accurate data set." The Examiner's Answer points to Tran's disclosure (par. [0027]) of incorporation of data from multiple sources in multiple formats. But Tran makes this disclosure in the context of the "background window" for providing "to the public free-of-charge with value added databases and services such as patent drafting assistance" It appears that Tran does not disclose searching intellectual property listings that were originally in different formats. Therefore, the purported suggestion to combine does not explain why a skilled artisan would be motivated to apply reformatting to the intellectual property listings before searching through the listings, as recited in claim 21.

In the Appeal Brief, the undersigned attorney wrote in several places that Tran does not disclose third-party sources of intellectual property listings. This was an overstatement. Tran does mention existence of auctions and exchanges. Tran apparently does not disclose searching the

listings of these auctions and exchanges from an aggregation portal. The Examiner's Answer does not contend that Tran discloses searching through the listings of such auctions and exchanges. Instead, it appears that the Examiner's Answer asserts that Tran discloses listing items for sale and searching through the listings. But the listings received in Tran are individual listings. They are not received from third-party sources of listings, such as auctions and exchanges.

As regards reliance on Applicant's own disclosure for suggestion to combine (Examiner's Answer, page 34), this is plainly inappropriate. "Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991) (emphasis added).

We also argued that the Office Action from which this Appeal is taken does not explain why "freezing of data at a predetermined point in time" would result in "giving a more accurate data set," which is the motivation to combine offered in the rejection. In response, the Examiner's Answer asserts (pages 35-36) that the motivation to combine is taken from the knowledge generally available to one of ordinary skill in the art, and directs attention to Kimball, stating that "Kimball gives a detailed description of snapshots." But knowledge of snapshots as such is not in dispute. What is in dispute is the assertion that "freezing of data at a predetermined point in time" would result in "giving a more accurate data set." Indeed, the statement "giving a more accurate data set" does not even explain the relevant baseline for the accuracy comparison: freezing of data results in a data set that is *more accurate than what?* We doubt that a snapshot of a data set is more accurate than the current data set itself.

The motivation to combine given in the rejection is inadequate.

C. Rejection of Claim 45 as Being Unpatentable Over Tran and Fischer

The Examiner's Answer acknowledged (page 45) that certain limitations appearing in the preamble of claim 45 have not been given patentable weight. Here, the body of claim 45 cannot stand alone because the claim's preamble provides antecedent for the recitation of "said third-party user-interface sites" in clause "c)" of the claim. Where the preamble provides the only antecedent basis and thus the context essential to understanding the meaning of a claim limitation, the preamble limits the scope of the claimed invention. *See Seachange Int'l, Inc. v. C-COR Inc.*, 413 F.3d 1361, 1376 (Fed. Cir. 2005) (citing *NTP, Inc. v. Research In Motion, Ltd.*, 392 F.3d 1336, 1358-59 (Fed. Cir. 2004)).

It was error to ignore the preamble limitation without which claim 45 would be incomplete.

D. Rejection of Claims 66 and 70

The Office Action from which this Appeal is taken rejected claims 66 and 70 under 35 U.S.C. § 103(a) as being unpatentable over Lundberg in view of Tran. The Examiner's Answer at pages 15-19 repeated the same § 103(a) rejection, but at pages 48-49 explained that the proper rejection of these claims "would have been" under § 102(e) as being anticipated by Tran. We respond to both rejections.

In rejecting claims 66 and 70, the Office Action and the Examiner's Answer reasoned that the limitation of instructions that "execute a query as specified by said user" reads on Tran's disclosure on "page 4 [0023] and [0029] [of] search engines [that] use the user profiles to search the web;

profile information including company affiliations, occupations, etc [0010].” We disagree with this statement because “profile information” is not a “query.”

The word *query*, as it relates to computer systems/databases, means a “user's (or agent's) request for information, generally as a formal request to a database or search engine.” Free On-Line Dictionary of Computing, *available online at* <http://foldoc.doc.ic.ac.uk/foldoc/index.html>. In numbered paragraphs [0010], [0023], and [0029], Tran does not teach executing a query specified by the user, *i.e.*, executing a purposeful request for information made by the user. Instead, Tran’s system captures

the users' profiles regarding their areas of interests, current occupations, company affiliations, demographic information (such as age, gender, income, geographic location and personal interests), and the users' behavior when they are online with the system. As a result, the system can deliver targeted advertisements based on information provided by users, actual Web sites visited, Web-site being viewed, or a combination of this information, and measure their effectiveness.

Tran, par. [0010].

The Examiner’s Answer (at pages 49-50) further cites Tran’s paragraphs [0008], [0011], and [0017], directing attention to the disclosure of searching by the users. Although Tran discloses a system that “allows parties to . . . search for applications” and enables a user to “search for desired IP asset,” Tran does not disclose that such searching is performed using a query. For example, a user of Tran’s system may search by browsing through displayed applications and other IP assets.

Finally, note that Tran’s system includes a portal and a downloadable intellectual property assistant. Tran, pars. [0016] and [0025]. Tran does not disclose that a query (even if the query itself

were disclosed) is executed by the intellectual property assistant. Tran also does not disclose that searching is performed by the assistant.

The functions performed by the downloadable assistant are generally described in paragraphs [0026] and [0027]:

After connecting to the portal, the assistant checks for the latest updates in his areas of Interest and show them in a small window at the bottom left portion of the screen. The client software performs multiple tasks, including establishing a connection to the portal; capturing demographic information; authenticating a user via a user ID and password; tracking Web-sites visited; managing the display of advertising banners; targeting advertising based on Web-sites visited and on keyword search; logging the number of times an ad was shown and the number of times an ad was clicked on; monitoring the quality of the online session including dial-up and network errors; providing a mechanism for customer feedback; short-cut buttons to content sites; and an information ticker for stocks, sports and news; and a new message indicator.

* * *

The assistant shows advertisements while its window is visible. If the user clicks on an advertisement or news or related feature, the assistant will automatically launch the browser and take the user to the advertiser's site.

Tran, pars. [0026] and [0027]. This description of the intellectual property assistant does not mention executing a query. It speaks of targeting advertising based on keyword search, but does not teach that the keyword search is performed from the intellectual property assistant. To the contrary, Tran discloses that searching is done by the portal through search engines, and the search results are then delivered to the user through the assistant:

The portal has access to IP search engines that continuously search the web and identify information that is of interest to its users. These search engines will use the user profiles to search the web and store the results in the user folders. This information is also relayed to the users using the assistant.

Tran, par. [0029].

Tran's portal is supported by a server 100. Tran, par. [0016]; *see also* Tran, Figure 1 (note that the server is misdesignated with reference numeral 110 in Tran's Figure 1). The server is separate from the client computers, to which the server is connected through a network. Thus, the functions performed at the server are not performed by the software application installed on a user's computing device. In contrast, claim 66 recites a software application for installment on said user's computing device, said application comprising instructions to execute a query as specified by said user, and search predetermined Internet sites and exchanges.

Tran does not disclose or suggest executing a query specified by the user, and does not disclose that the steps of executing a query and searching are performed from the user's computing device. Therefore, Tran does not anticipate or render obvious claim 66. Claim 70 recites limitations similar or identical to those in claim 66, but in "means for" apparatus element form. Claim 70 is patentable for the same reason as discussed above in relation to claim 66.

E. Rejection of Claim 3 as Being Unpatentable Over Lundberg and Tran

Claim 3 recites a step of "securing from each of said plurality of third-party sources of intellectual property listings a fee-sharing agreement." In the Appeal Brief, we argued that while the Office Action points to the disclosure of various fees by Tran, it does not point to a disclosure of fee sharing agreements by Tran. In response, the Examiner's Answer (page 52) once again points to the disclosure of various fees, and then asserts (pages 52-53) that Tran discloses an agreement to pay fees. Neither the Office Action nor the Examiner's Answer point to a disclosure of fee-sharing

agreement. The *sharing* limitation should not have been ignored.

F. Rejection of Claim 10 as Being Unpatentable Over Lundberg and Tran

Claim 10 recites a step of “reordering said intellectual property listings stored in said buffer memory according to predefined criteria prior to presentation thereof to said at least one of said plurality of users.” We have argued that Lundberg does not disclose this reordering step. In particular, we have argued that Lundberg’s paragraphs [0007] and [0009] cited in the Office Action disclose “grooming” records after presentation to the user, while claim 10 requires the reordering criteria to be defined prior to presentation to the user, because the criteria is predefined. Lundberg does not disclose performing such “reordering” in accordance with predefined criteria prior to presentation to the user.

The Examiner’s Answer now also points to Lundberg’s paragraphs [0011] and [0019]. Paragraph [0011] may disclose additional searching and adding newly-found records to the previously-found records, but it does not disclose reordering of either the previously-found records nor the newly-found records. Lundberg’s paragraph [0011] is simply silent as to changing the order of the records. The order of the previously-found records may remain the same as it was before the addition of the new records, for example. Paragraph [0019] discloses “determining the number of patents held in a particular area, or the number of patents to expire in a given year.” It does not address reordering.

G. Rejection of Claim 88 as Being Unpatentable Over Lundberg and Tran

The additional limitations recited in claim 88 read as follows: “wherein the plurality of third-party sources of intellectual property listings available for transacting comprises third-party sources selected from the group consisting of an exchange site and an auction site.” In rejecting this claim, the Office Action from which this Appeal is taken did not point out where Lundberg and Tran disclose searching a plurality of third-party exchanges and/or auction sites. The Examiner’s Answer also did not point out such teaching. Instead, the Examiner’s Answer cited paragraph’s [0006] and [0009] of Tran. These paragraphs disclose Tran’s own system that provides online trading. Tran does not disclose that the system searches other (third-party) auctions or exchanges.

H. Rejection of Remaining Dependent Claims

Dependent claims that are not specifically addressed in the above arguments are patentable at least for the reasons discussed in relation to their respective base claims and intervening claims, if any.

IV
CONCLUSION

For the foregoing reasons, Applicant-Appellant respectfully submits that all pending claims are patentable over the references and respectfully requests reversal of the rejections.

Respectfully submitted,



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Dated: October 20, 2006